

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s):	Jarmo Makela	CONF. NO.	5743
SERIAL NO.:	09/827,489	ART UNIT:	2614
FILING DATE:	04/06/2001	EXAMINER:	MD S ELAHEE
TITLE:	ACTIVATION OF A TELEPHONE'S OWN CALL ANSWERING EQUIPMENT ACCORDING TO THE NUMBER OF THE CALLING PARTY		
ATTORNEY DOCKET NO.:	297-006914-US(C01)		

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

INTRODUCTION

This is in response to the Final Office Action mailed March 6, 2008 in regard to the above-identified patent application. Request is made for a conference by a panel of examiners to review the appealable issues raised by the Office Action.

In the Office Action, Claims 10-11, 18-19, 21-22, 27, 31, 35, 39 and 41-42 were said to have allowable subject matter. Accordingly, these claims are not being considered in this request for review by the conference of examiners. Also, the rejection of all of the claims 1-42 under double patenting (Point 6 of the Action) is not being considered in this request for review.

Claims 1, 7-9, 12-13, 20, 23-26, 29-30, 33-34, and 37-38 (which includes all of the independent claims) were rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky (US 5,559,860) in view of Kang (US 5,058,150) for reasons set forth in the Action. The remaining ones of the rejected claims, namely, claims 2-6, 14-17, 28, 32, 36, and 40 were rejected on the combined teachings of Mizikovsky and Lang considered in combination with various ones of

Jambhekar (US 5,848,356), Bremer (US 6,018,671), Villa-Real (US 4,481,382), and Wolff (US 5,327,486).

Reconsideration of the rejection of the claims is respectfully solicited in light of the following analysis and argument.

ANALYSIS

Claims 1, 20, 23, 24, 25, 29, 33, and 37 are independent, and are rejected. Of the independent claims, claims 1, 23, 25, and 29 are directed to a method, and claims 20, 24, 33, and 37 are directed to an apparatus.

Method claim 23 may be taken as being representative of the claimed subject matter, and is directed to a method for replying to a call by a portable terminal, wherein the portable terminal is capable of sending a reply in any one of a plurality of modes of response, irrespectively of which of the plurality of modes of response is employed in a selected response. Claim 23 reads as follows:

23. A method for replying to a call by a portable terminal, comprising the steps of:

in response to an incoming call, the portable terminal identifies a caller on the basis of caller identification information, and sends a reply or directs the incoming call to another answering service, said portable terminal being capable of sending a reply in any one of a plurality of modes of response, said reply being in a one of said plurality of modes of response; and

wherein said step of identifying the caller is accomplished by said portable terminal, and said step of sending a reply is accomplished by said portable terminal irrespectively of which of said plurality of modes of response is employed in a selected response.

THE POSITION OF THE EXAMINER

In Point 10 the Final Action, the examiner rejects all of the independent claims for the same reasons. Most of the limitations in claim 23, as well as in the other independent claims, are said

to be taught by Mizikovsky, the primary reference. Mizikovsky deals with the subject matter of a mobile terminal coupled to various accessory devices and operating in cellular communication system, wherein, in response to an incoming call, the mobile terminal can address a response to a selectable one of the accessory devices.

The examiner notes that Mizikovsky does not teach that a portable device, acting exclusively, sends a response to a caller via a selected accessory device, nor that such an accessory device is integrated with the mobile terminal. The examiner relies on Kang to provide the missing teaching. The examiner notes that Kang discloses construction of a telephone answering machine integrated into a radio telephone. In so far as the examiner's position is understood, the examiner appears to state that, since Kang is able to integrate an answering machine into a common structure with a radio telephone, then it is obvious to integrate the several accessory devices of Mizikovsky into a single portable device.

APPLICANT'S ARGUMENT

The foregoing position of the examiner is traversed respectfully because it is believed that a combination of some form of electronic device with a radio telephone does not, by itself, mean that all forms of electronic devices can be combined with radio telephones.

With respect to the above cited claim 23, the teaching that - - the portable terminal is capable of sending a reply in any one of a plurality of modes of response, irrespectively of which of the plurality of modes of response is employed in a selected response - - is clearly absent in Kang who discloses only one device (answering machine) integrated with the radio telephone. In Mizikovsky, the accessory devices are separate from the radio telephone. Thus, there would be no motivation to combine these references for rejection of the claims, and there is a clear distinction between the teachings of the cited art and the claimed subject matter, as may be appreciated from the following argument.

It is noted that all of the rejections are based on at least the combination of Mizikovsky with Kang, and wherein for rejections of some of the claims, additional references are combined with Mizikovsky and Kang. With respect to the rejections of the independent claims, all of which are rejected on the combination of Mizikovsky with Kang, the examiner cites features of Kang,

concerning the portability or mobility of a telephone, that are not compatible with, and thus not supported by a dictionary reference.

According to the cited dictionary, a car phone is a *cellular* phone *installed in* a vehicle. The dictionary also says that there are four types of *cellular* phones: mobile, transportable, portable and handheld. From this the Examiner somehow draws the conclusion that a car phone would be portable.

The conclusion is logically invalid, because in general if we say that A is one type of C, and that there are known four categories M, T, P, and H of C, that still does not tell, whether A can appear in all four categories. Even more convincingly, if something is *installed in a vehicle*, it can hardly be portable.

In addition to the foregoing matter of portability or mobility of the telephone, there is a further issue that must be addressed for invalidating the examiner's position that the claims are obvious.

It appears that the Examiner fails to address, in the present Office Action, the Applicant's argument against a finding of obviousness in light of Mizikovsky and Kang, which argument appears in the response to the previous Office Action (beginning at the middle of page 14). Let us reiterate this last part of the response with slightly different words.

The point is that there is no combination, obvious or not, which can be produced from the disclosures of Kang and Mizikovsky to give a portable device that would be capable of selecting the response from a plurality of forms of communication and, furthermore, be capable of sending the response selected from the plurality of forms of communication exclusively through its (the portable device) own actions.

The clear and unambiguous teaching of Mizikovsky is that, to obtain a plurality of forms of communication, there is need to employ a range of auxiliary devices. Employment of the range of auxiliary devices clearly makes the combined aggregate apparatus non-portable.

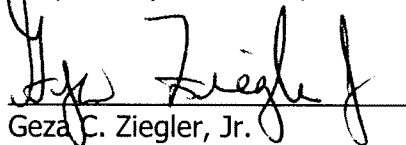
The teaching of Kang is that, to construct a car phone with an integrated but otherwise conventional telephone answering machine, this may be accomplished by building the answer machine on an option board that is then installed into the telephone apparatus. However, such

construction will only provide a single form of communication to choose from. Thus, there is no way of combining the teachings of Mizikovsky and Kang to provide a resulting device which meets the presently claimed limitation "plurality of forms of communication", unless one were to employ the multitude of auxiliary devices of Mizikovsky.

Accordingly, the rejection by the examiner should be reversed so as to find allowable subject matter in the claims.

The Commissioner is hereby authorized to charge payment of \$180 for the Notice of Appeal (\$330 paid with Notice of Appeal filed on May 13, 2004) and for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

6 JUNE 2008
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512